

DRAWING AMENDMENTS

-- Please amend the drawings by cancelling the originally submitted drawings sheets 1 and 2 and replacing with the replacement sheets 1 and 2 of the formal patent drawings, which are submitted herewith. --

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SERIAL NO. 10/728,564**

REMARKS**I. Claim Rejections – 35 U.S.C. § 102*****Requirements for Prima Facie Anticipation***

A general definition of *prima facie* unpatentability is provided at 37 C.F.R. §1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), adopted, 149 USPQ 640 (Ct. Cl. 1966)), cert. denied, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the reference cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the Applicant needs to only demonstrate that not all elements of a *prima facie* case of anticipation have been met, i.e., show that the prior art reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

Berardi

Claims 1, 2, 7, 13, 14 and 26-31 were rejected under 35 U.S.C. 102(e) as being anticipated by Berardi (U.S. Patent Application Publication No. 2003/0167207).

The Examiner argued that Barardi shows a method for providing access to a financial transaction, where the system includes two versions of the transporter 102. The Examiner admitted that the first embodiment of transponder 102 does not include a fingerprint reader (the Examiner referred to FIG. 2); the Examiner, however, interpreted this as a badge. The Examiner further argued that the second embodiment of transporter 102 includes a fingerprint reader (citing FIG. 9); and that this is interpreted as a keyfob. The Examiner asserted that the figure 9 transponder sends the fob ID (arguing that it is stored in memory 214) with the fingerprint so both can be authenticated. The Examiner further stated that when data is read from the transponder, a comparison is made to authorize financial access; and that this meets the limitation of determining if the received code is authentic and providing access upon authentication. The Examiner also asserted that if the data is from a badge, the authorization step compares account data (or, the Examiner argued, transponder ID), paragraph 59. The Examiner asserted that if the data is from a keyfob the authorization step compares fingerprint data, citing paragraph 141. The Examiner argued that it his position that in order to compare the received data from the FIG. 9 transponder with stored fingerprint data, a decision inherently is made that the data received includes fingerprint data. The Examiner argued that this meets the limitation of determining if the code is from a badge or a keyfob.

The Applicant respectfully disagrees with this assessment. It is unclear how a fingerprint reader can be interpreted as a badge or how a finger print reader can also be interpreted as a keyfob. A keyfob is not a fingerprint reader and the badge (as taught by Applicant) is also not a fingerprint reader. The limitation of

determining whether a code is a badge or keyfob is simply not taught by Berardi because the fingerprint reader of Berardi cannot constitute both a badge and a keyfob and there is not disclosure, hint or suggestion of Applicant's badge and keyfob in Berardi.

Additionally, applicant's claim 1 as amended includes the features of "wherein the authentication code from the fingerprint keyfob comprises a digitized fingerprint signature and a rolling identifier, and wherein the processor is arranged to perform an authentication of the authentication code based upon both the digitized fingerprint signature and the rolling identifier in the authentication code from the fingerprint keyfob". Such features are not taught, suggested or disclosed by Berardi. As such, the Applicant submits that the rejection to claim 1 under 35 U.S.C. 102 based on Berardi is traversed. The Applicant submits that this also applies to the rejection to claim 2.

Amended claim 7 includes the features of "wherein the authentication code from the fingerprint keyfob comprises a fingerprint signature and an identifier, and wherein the determining of whether the authentication code is authentic comprises determining whether both the fingerprint signature and the identifier in the authentication code from the fingerprint keyfob are authentic". These features are also not taught, suggested or disclosed by Berardi. Thus, the rejection to claim 7 under 35 U.S.C. 102 based on Berardi is also traversed. The Applicant submits that this argument also applied to the rejection to claim 13, which depends from claim 7.

Amended claim 14 includes the features of "transmitting a stimulus signal that causes at least one of the badge and the keyfob to transmit the signal containing the authentication code, wherein the authentication code from the keyfob comprises first and second portions, wherein the first and second portions are different types of codes, and wherein the determining of whether the authentication code is authentic comprises determining whether both the first and second portions are authentic and wherein the first portion comprises a rolling

Identifier". Such features are not taught, suggested or disclosed by Berardi. As such, the rejection to claim 14 under 35 U.S.C. 102 is also traversed.

Regarding claims 26-31, the Applicant notes that Berardi does not disclose the following claim limitations: receiving an RF signal containing an authentication code; determining whether the authentication code is of a first type or of a second different type; processing the authentication code in a first manner if the authentication code is of the first type and processing the authentication code in a second different manner if the authentication code is of the second different type to determine whether the authentication code is authentic; and, if the authentication code is authentic, permitting access. Berardi actually only describes one type of authentication code or authenticator and that relates to the biometric sensor described Berardi, but does not relate use of a first type or of a second different type and first and second manners of processing the authentication code. The transponder cited by the Examiner is not even an authenticator. Instead, it is simply a transponder, not an authenticator. As such, the Applicant submits that the rejection to claims 26-31 is traversed. Applicant respectfully requests withdrawal of the rejections to claims 1, 2, 7, 13, 14, and 26-31 under 35 U.S.C. 102.

II. Claim Rejections – 35 U.S.C. § 103

Requirements for Prima Facie Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection), an applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992). Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned basic criteria has been met.

Berardi, Fuku

Claims 4, 5, 8, 10, 11, 15, 16, 18, 20, 22, 23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Berardi as applied in claims 1 and 2 above, and further in view of Fuku (U.S. Patent No. 6,868,170).

The Examiner argued that Berardi shows a method for providing access where the system includes two versions of the transponder 102. The Examiner asserted that Berardi shows fingerprint data being compared, but does not exactly teach a specific method or apparatus to perform such a function. The applicant notes that the fingerprint data of Berardi is not compared based on the use of a keyfob and a badge.

The Examiner also argued that in an analogous art, Fuku shows a security system that extracts fingerprint data from a sensor 11 and converts the fingerprint

data into digital data 12 that can be compared to data in a storage unit 13 for access authorization. The Examiner argued that this converting a comparing allows for easy processing of the fingerprint authentication process. The Examiner asserted that it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the fingerprint authorization process and elements in the Berardi system since it would provide processing of the desired fingerprint authorization of Berardi.

The Applicant notes that Fuku when combined with Berardi does not teach, suggest or disclose each and every one of the following claim limitations:

4. The security system reader of claim 2 wherein the processor supplies the authentication code to the transceiver, which causes the authentication code to be transmitted in an RF signal.

5. The security system reader of claim 2 wherein the processor compares the digitized fingerprint signature to fingerprint signatures in a list of fingerprint signatures and also compares the rolling identifier in the authentication code from the fingerprint keyfob to an identifier maintained by the processor.

10. The method of claim 7 wherein the fingerprint signature comprises a digitized fingerprint signature.

11. The method of claim 7 wherein the determining of whether the authentication code is authentic comprises: comparing the fingerprint signature to fingerprint signatures in a list of fingerprint signatures; and, comparing the identifier in the authentication code from the fingerprint keyfob to a separately maintained identifier.

15. The method of claim 14 further comprising providing a rolling identifier generator that generates the rolling identifier.

16. The method of claim 15 wherein the rolling identifier comprises a code that is randomly or pseudorandomly generated by the rolling identifier generator

18. The method of claim 14 wherein the determining of whether the authentication code is authentic further comprises:

comparing the first portion to a list; and,
comparing the second portion to a separately maintained code.

20. The method of claim 14 wherein the authentication code from the keyfob comprises a digitized fingerprint signature and an identifier, and wherein the determining of whether the

authentication code is authentic comprises determining whether both the digitized fingerprint signature and the identifier are authentic.

23. The method of claim 20 wherein the determining of whether the authentication code is authentic comprises:

comparing the fingerprint signature to fingerprint signatures in a list of fingerprint signatures; and,

comparing the identifier in the authentication code from the keyfob to a separately maintained identifier.

The Applicant notes that the rejection to claims 4, 5, 8, 10, 11, 15, 16, 18, 20, 22, 23 were rejected under 35 U.S.C. 103(a) fails under all three prongs of the aforementioned *prima facie* obviousness test. First, there is no suggestion or motivation, either in the Berardi/Fuku references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine these reference teachings to provide for each and every claim limitation of claims 4, 5, 8, 10, 11, 15, 16, 18, 20, 22, 23. Second, the Examiner has not postulated how and why a reasonable expectation of success would result from the combination of Berardi/Fuku. What aspects of Fuku and Berardi suggest such a "reasonable expectation of success?" Third, the Examiner has not identified where and how EACH and EVERY claim limitation of claims 4, 5, 8, 10, 11, 15, 16, 18, 20, 22, 23 are taught by Berardi/Fuku.

With regard to the first prong of the *prima facie* obviousness test, the Applicant reminds the Examiner that the language of the references may not taken out of context without a motivation for such a combination, in effect producing the words of the claims (and sometimes, not even the words or concepts of the claims), without their meaning or context. The resultant combination of references would not yield the invention as claimed. Claims 4, 5, 8, 10, 11, 15, 16, 18, 20, 22, 23 are rejected under 35 U.S.C. §103(a) and no showing has been made to provide the motivation as to why one of skill in the art would be motivated to make such a combination, and further fails to provide the teachings necessary to fill the gaps in order to yield the invention as claimed. The rejections under 35 U.S.C. §103(a)

have provided no more motivation than to simply point out the individual words of the Applicant's claims among the Petersen, but without the reason and result as provided in the Applicant's claims and specification, and without reason as to why and how the references could provide the Applicant's invention as claimed. Hindsight cannot be the basis for motivation, which is not sufficient to meet the burden of sustaining a 35 U.S.C. §103(a) rejection.

Thus, claims 4, 5, 8, 10, 11, 15, 16, 18, 20, 22, 23 of the present invention are therefore not taught or suggested by Berardi and/or Fuku. Combining these references as suggested by the Examiner fails to teach or yield the invention as claimed. The combination of the references fails to teach or suggest all the elements of claims 4, 5, 8, 10, 11, 15, 16, 18, 20, 22, 23. Further, one of skill in the art would not be motivated to make such a combination. Therefore, the present invention is not obvious in light of any combination of Berardi/Fuku. Withdrawal of the §103(a) rejection to claims 4, 5, 8, 10, 11, 15, 16, 18, 20, 22, 23 is therefore respectfully requested.

The Applicant also notes that the rejection to claim 8 and 22 is moot in light of the cancellation of claims 8 and 22 by amendment as indicated herein.

Berardi, Fuku, Fitzgibbon

Claims 3, 6, 9, 12, 17, 19, 21, and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Berardi and Fuku as applied to the claims above, and further in view of Fitzgibbon (U.S. Patent Application Serial No. 2003/0210131).

The Examiner argued that in analogous art Fitzgibbon teaches an access security system where a transmitter can send codes to a garage door for access authorization. The Examiner asserted that the portable transmitter can additionally include a fingerprint reader to send information regarding the user's fingerprint, also for authorization. The Examiner asserted that Fitzgibbon is cited for teaching

that in this type of system, the use of rolling codes can improve the security of the system. The Examiner referred to FIG. 5 in support of this argument.

The Examiner argued that it would have been obvious to one of ordinary skill in the art at the time of the invention to have used rolling codes in the above-modified system since rolling codes can increase the security of an access system.

The Applicant notes that the rejection to claims 3, 6, 9, 12, 17, 19, 21, and 24 were rejected under 35 U.S.C. 103(a) fails under all three prongs of the aforementioned *prima facie* obviousness test. First, there is no suggestion or motivation, either in the Berardi/Fuku/Fitzgibbon references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine these reference teachings to provide for each and every claim limitation of claims 3, 6, 9, 12, 17, 19, 21, and 24. Second, the Examiner has not postulated how and why a reasonable expectation of success would result from the combination of Berardi/Fuku/Fitzgibbon. What aspects of Fuku and Berardi and Fitzgibbon suggest such a "reasonable expectation of success?" Third, the Examiner has not identified where and how EACH and EVERY claim limitation of claims 3, 6, 9, 12, 17, 19, 21, and 24 are taught by Berardi/Fuku/Fitzgibbon.

With regard to the first prong of the *prima facie* obviousness test, the Applicant reminds the Examiner that the language of the references may not taken out of context without a motivation for such a combination, in effect producing the words of the claims (and sometimes, not even the words or concepts of the claims), without their meaning or context. The resultant combination of references would not yield the invention as claimed. Claims 3, 6, 9, 12, 17, 19, 21, and 24 are rejected under 35 U.S.C. §103(a) and no showing has been made to provide the motivation as to why one of skill in the art would be motivated to make such a combination, and further fails to provide the teachings necessary to fill the gaps in order to yield the invention as claimed. The rejections under 35 U.S.C. §103(a)

have provided no more motivation than to simply point out the individual words of the Applicant's claims among the Petersen, but without the reason and result as provided in the Applicant's claims and specification, and without reason as to why and how the references could provide the Applicant's invention as claimed. Hindsight cannot be the basis for motivation, which is not sufficient to meet the burden of sustaining a 35 U.S.C. §103(a) rejection.

Thus, claims 3, 6, 9, 12, 17, 19, 21, and 24 of the present invention are therefore not taught or suggested by Berardi and/or Fuku and/or Fitzgibbon. Combining these references as suggested by the Examiner fails to teach or yield the invention as claimed. The combination of the references fails to teach or suggest all the elements of claims 3, 6, 9, 12, 17, 19, 21, and 24. Further, one of skill in the art would not be motivated to make such a combination. Therefore, the present invention is not obvious in light of any combination of Berardi/Fuku/Fitzgibbon. Withdrawal of the §103(a) rejection to claims 3, 6, 9, 12, 17, 19, 21, and 24 is therefore respectfully requested.

III. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §102 and §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



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